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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/508,028	10/30/2000	Graham M. Chapman	PET 43 US	7881

7590 10/24/2002
Waters & Morse
400 Ledyard Building
125 Ottawa NW
Grand Rapids, MI 49503

EXAMINER

NGUYEN, KIMBERLY T

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 10/24/2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/508,028

Applicant(s)

CHAPMAN ET AL

Examiner

Kimberly T. Nguyen

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2002.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 1774

DETAILED ACTION

Response to Amendment

This action is in response to the amendment submitted on August 6, 2002.

Claim Rejections - 35 USC § 112

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

In claim 1, it is not clear what is meant by the terms "inherent cling."

The terms "surface energy...is *greater* than the paint at the time of use" in claim 1 are relative terms which renders the claim indefinite. The term "greater" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

In claim 10, it is not clear what the "inner surfaces of the material" are. It is not clear if this is the inner surfaces of the layers or the bottom layer.

In claim 17, it is not clear what is meant by the term "dismissible."

The terms "relatively weak" in claim 18 is a relative term which renders the claim indefinite. The terms "relatively weak" are not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

In claim 16, it is not clear what the "post-consumer recycled material" comprises. Further, the specification does not provide any disclosure as to what the material comprises.

Claim Rejections - 35 USC § 103

Art Unit: 1774

Claims 1-15 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roberts et al., U.S. Pat. No. 5,096,761 in view of Verschieren, U.S. Pat. No. 5,491,032.

Roberts shows a co-extruded masking film comprising a HDPE layer (inner layer), a LLDPE core layer, and another EVA or HDPE layer (outer layer) (column 4, lines 59-68 and column 5, line 49 to column 6, line 57). Roberts shows that no adhesive may be used when the film is used for masking (column 15, lines 11-39). Roberts shows that the masking film can be stored in rolls (column 13, lines 53-68). Roberts also shows that the film has overall enhanced tensile strength (column 15, lines 1-10). Roberts shows that particulate fillers such as carbon black (colorant) are used in the masking film (column 1, lines 26-35).

Though Roberts shows that high voltage irradiation (corona treatment) may be employed to enhance toughness and the like to the film (column 14, line 50 to column 15, line 10), Roberts does not specifically show that the irradiation is a corona treatment wherein the film is treated to a level of at least 50 dynes/cm to produce sufficient surface energy of the outer layer as in instant claims 1 and 10. Verschieren shows a masking film wherein HDPE films are corona-treated such that a surface tension of 45 dyn/cm is achieved so that lacquer paints adhere well to the film (column 1, lines 34-45). It would have been obvious to one of ordinary skill in the art at the time the invention was made to corona-treat the HDPE layer of Roberts because it is known that such a treatment enhances the adherence of paints to HDPE layers and avoids paint flaking off of the HDPE layers when used for surface protection of substrates when painting.

Roberts does not show the thicknesses of the inner, core, and outer layers as in instant claim 9 or that the film is at least about 18 inches wide as in instant claim 10. However, such a film size or thicknesses are properties which can be easily determined by one of ordinary skill in

Art Unit: 1774

the art. With regard to the limitation of the sheet size or thicknesses, absent a showing of unexpected results, it is obvious to modify the conditions of a composition because they are merely the result of routine experimentation. The experimental modification of prior art in order to optimize operation conditions (e.g. sheet size and thicknesses) fails to render claims patentable in the absence of unexpected results. All of the aforementioned limitations are optimizable as they control the amount or level of coverage which the masking sheet can provide and the mechanical strength and opacity of the film. As such, they are optimizable. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the masking sheet with the limitation of the sheet size since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Roberts et al., U.S. Pat. No. 5,096,761 in view of Verschaeren, U.S. Pat. No. 5,491,032 in further view of Gurewitz, U.S. Pat. No. 5,364,695.

Roberts and Verschaeren are relied upon as above for claim 10. Roberts does not show that the core layer comprises post-consumer recycled material as in instant claim 16. Gurewitz shows a thermoplastic film comprising an outer HDPE layer, a LDPE core layer, and another HDPE inner layer wherein the film has improved surface adhesion as a result of corona treatment of at 35 to 72 dynes (Abstract and column 3, lines 26-39). Gurewitz shows that the LDPE core layer can include recycled plastic (column 5, lines 44-60). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the core layer in the masking

Art Unit: 1774

film of Roberts with recycled plastic because it is known, as shown in Gurewitz, that masking films of improved surface adhesions can be effectively comprised of recycled plastics.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Roberts et al., U.S. Pat. No. 5,096,761 in view of Verschaeren, U.S. Pat. No. 5,491,032 in further view of Cooper et al., U.S. Pat. No. 4,337,284.

Roberts and Verschaeren are relied upon as above for claim 10. Roberts does not show that the masking film has a relatively weak cross-directional tear to facilitate tearing as in instant claim 18. Cooper shows a film tear-tape comprising laminates of two or more layers of a thermoplastic LDPE substrate and an EVA layer wherein the tape can be torn at an angle to the plane of the film (column 1, lines 10-30). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the masking film of Roberts tearable since it is known and shown in Cooper that EVA, HDPE, and LLPE layers in a film can be torn for packaging purposes.

Response to Arguments

Applicant's arguments with respect to claims 1-9 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's AMENDMENT necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

Art Unit: 1774

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly T. Nguyen whose telephone number is (703) 308-8176. The examiner can normally be reached on Monday to Friday, except on every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on (703) 308-0449. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Kimberly T. Nguyen
Examiner
October 21, 2002

CYNTHIA H. KELLY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700

